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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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Black & Decker Inc.
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EXAMINER

BLAKE, CAROLYN T

ART UNIT PAPER NUMBER

3724

DATE MAILED: 12/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/688,668

Applicant(s)

SHEDDY ET AL.

Examiner

Carolyn T. Blake

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 66-69 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☒ Claim(s) 66-69 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 15, 2006 has been entered.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

3. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee (6,272,961) in view of Jameson (3,777,792), Weissman (4,885,965), Mayfield (5,063,806), Rueb (5,577,428), Welch (5,906,538), Greenland (6,080,041), and Gorgol et al (6,273,081).

Lee discloses the device substantially as claimed, including a saw comprising: a base (50); a frame assembly (20) disposed on the base (50); a first rail (221) disposed on the frame assembly (20), the first rail (221) having a longitudinal axis; a table (30) slidably disposed on the first rail (221), the table (30) being movable in a direction substantially parallel to the longitudinal axis; a saw assembly (60) disposed on at least one of the base (50) and the frame assembly (20), the saw assembly (60) comprising a support assembly (23), a motor assembly (41) pivotably supported by the support

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assembly (23), the motor assembly (41) being pivotable about a pivot axis substantially parallel to the longitudinal axis, and a cutting wheel (42) driven by the motor assembly (41), the cutting wheel (42) having a plane substantially parallel to the pivot axis; and a switch (on controlling head 45) electrically connected to the motor assembly (41). Lee fails to disclose the switch remains stationary when the motor is pivoted. However, Jameson, Weissman, Mayfield, Rueb, Welch, Greenland, and Gorgol et al disclose saws with switches in various locations. These references are cited as cumulative evidence that a switch can be placed almost anywhere on a saw. Thus, even though the specific location of the switch that Applicant is claiming is not specifically taught, the indication from the prior art is that the location of the switch would have been an obvious matter of choice dependent on the suitability of that location for whatever desired reason, such as dexterity, eye coordination, or standing position of the operator, ease of manufacturing, or position of the work piece and/or product. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a switch on the saw as claimed, as suggested by Jameson, Weissman, Mayfield, Rueb, Welch, Greenland, and Gorgol et al, on the Lee device in order to accommodate dexterity, eye coordination, or standing position of the operator, ease of manufacturing, or position of the work piece and/or product.

In addition, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the switch in an alternative location in order to accommodate dexterity, eye coordination, or standing position of the operator, ease of manufacturing, or position of the work piece and/or product since it has been held the

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shifting of parts to different positions is a known variable. *In re Japikse*, 86 USPQ 70 (CCPA 1950).

Regarding claim 2, Lee discloses the first rail (221) has a first end, and the table (30) is movable beyond the first end.

Regarding claim 3, Lee discloses the table (30) is movable beyond the base (50).

Regarding claim 4, Lee discloses the base (50) is formed as a tub.

4. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lee in view of Jameson, Weissman, Mayfield, Rueb, Welch, Greenland, and Gorgol et al as applied to claim 1 above, and further in view of Klingens (2,691,398).

The modified Lee device fails to disclose the frame is made of aluminum. However, Klingens discloses a saw wherein the frame is made of aluminum. Aluminum is a good material choice for a sturdy component such as a frame because it can be easily used in casting operations. See col. 2, lines 29-34. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use aluminum for the frame, as disclosed by Klingens, on the modified Lee device because aluminum can be easily used in casting operations.

Response to Amendment

5. The affidavit under 37 CFR 1.132 filed November 15, 2006 is insufficient to overcome the rejection of the claims based upon the 35 USC § 103 rejection of Lee in view of Jameson, Weissman, Mayfield, Rueb, Welch, Greenland, and Gorgol et al as set forth in the last Office action because of the following reasons.

The affidavit appears to be rebutting the prima facie case. However, only two types of affidavits can accomplish this task: (1) affidavits demonstrating unexpected results or properties; or (2) affidavits establishing secondary consideration of non-obviousness, such as long felt need or commercial success. In the Remarks section, Applicant argues the affidavit has been submitted to show criticality and cites MPEP § 706.01(a) as a reference. First of all, this is not a valid section of the MPEP. In addition, a showing of criticality is not a valid way to rebut the prima facie case. Affidavits showing criticality generally relate to ranges. See MPEP § 716.02(d).

Also, on page 14 of the Remarks section, Applicant noted, "Moreover, the fact that other beveling head tile saws had been on the market without stationary switches, and that the present invention was the first to introduce a stationary switch on such a tile saw is evidence of a long felt need for such a switch." This is insufficient to show long felt need. First of all, many of the references cited as prior art show stationary switches in conjunction with moving saws. In addition, there is no showing that others of ordinary skill in the art were working on the problem and if so, for how long. Also, there is no evidence that if persons skilled in the art who were presumably working on the problem knew of the teachings of the above cited references, they would still be unable to solve the problem. See MPEP § 716.04.

In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

Allowable Subject Matter

6. Claims 66-69 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

7. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

While Applicant argues the position of the switch is critical, the criticality of the switch is not presented in the original disclosure. Applicant points to paragraph 133 and FIGS 1 and 13A (shown in phantom) of the specification to demonstrate criticality of the switch. However, the paragraph and figures merely show the existence of a switch in the device, and do not demonstrate its criticality. Certainly, if the switch were a critical element of Applicant's design, more than two vague sentences and figures would be used to discuss it in the rather extensive disclosure. As such, Applicant's assertion that the location of the switch is critical appears to be an afterthought.

In response to Applicant's argument that the examiner suggested a different reason for modifying switch placement than Applicant, the fact that Applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

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Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn T. Blake whose telephone number is (571) 272-4503. The examiner can normally be reached on Monday to Thursday, 7:00 AM to 5:30 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer D. Ashley can be reached on (571) 272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CB

CB

December 11, 2006



BOYER D. ASHLEY
SUPERVISORY PATENT EXAMINER